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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,378	10/27/2000	William Kopaciewicz	550P002C3	6511

7590                    03/19/2003

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FORTUNA, ANA M

ART UNIT	PAPER NUMBER
1723	4

DATE MAILED: 03/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No. 09/698,378	Applicant(s) Kopaciewicz et al
Examiner Ana Fortuna	Art Unit 1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on Oct 27, 2000

2a)  This action is FINAL.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-16 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-16 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2, 3

6)  Other:

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## DETAILED ACTION

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CAR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CAR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CAR 3.73(b).

2. Claims 1-16 are rejected under the judicially created doctrine of double patenting over claims 1-10 and 11-20 of U. S. Patent No. 6,048,457. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the present invention are directed to the housing provided with the tridimensional structure comprising a

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plurality of sorptive particles entrapped in a porous polymer matrix. The housing being a pipette, and having the spect ratio as in claims 3 and 5 of the present invention are included in claims 1, and 4 of the claims in the patent, additional limitations are also covered by the limitations of the claims in the patent.

3. Claims 1-4, 7-14, and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11, 13-22 of U.S. Patent No. 6,200,474 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations of the claims are overlapped by the limitations of the claims in the patent.

***Claim Rejections - 35 U.S.C. § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35

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U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1, 2, 4, 5, 6, 7, 8, 9, 10, 11, 12, 14, 15 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Dusterhoft et al (6,451,260 B1(hereinafter ‘260) (Equivalent to WO 98/08594). The later reference have been discussed in detail in the parents files. Reference ‘260 discloses the housing an membrane comprising a plurality of sorptive particles, e.g. polystyrene divinylbenzene, silica, etc (abstract, column 18, lines 34-43, Fig.1, elements 1, 3, 4). Continuity between membrane and housing can be observed in the Figure(1). Regarding to the housing as pipette, and housing or support materials, and membrane or matrix materials are also disclosed in reference ‘260 (column 8, lines 33-42, column 2, lines 39-42, column 3, lines 43-60, column 4, lines 62-68, column 5, lines 1-12, column 7, lines 24-30, and column 15, lines 29-45).

#### *Claim Rejections - 35 U.S.C. § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dusterhoft et al (6,451,260 B1(hereinafter ‘260) as applied to claims 1-2, 4-12, 14-14 above, and further in view of Kapulprathipanja et al (5,127,925)(hereinafter ‘925). Reference ‘260 fails to disclose the

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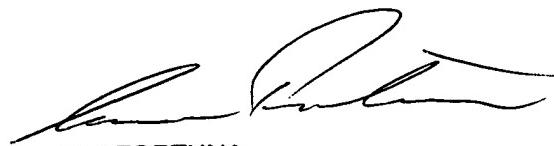
membrane or matrix material as polysulfone. Reference '925 teaches making a membrane having sorptive properties using polysulfone as matrix material, and having sorbents incorporated therein (abstract, column 5, lines 20-68, column 6, lines 1-4), reference '925 teaches polyamide and polysulfone as equivalents for forming a mixed membrane, e.g. membrane including adsorbent particles (column 7, lines 25-38). It would have been obvious to one skilled in the art at the time the invention was made to use polysulfone for the membrane of reference '260, as alternative polymer for cellulose or polyamide.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana Fortuna whose telephone number is (703) 308-3857. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached on (703) 308-0457. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for regular responses, and (703)872-9311 for after finals.

Ana Fortuna

March 10, 2003



ANA FORTUNA  
PRIMARY EXAMINER